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In re Application of MYERS et al. :
Application No.: 09/673,133 :
PCT No.: PCT/CA99/00307 :
Int. Filing: 12 April 1999 :
Priority Date: 14 April 1998 : DECISION ON PETITION
Attorney Docket No.: 1038-1102 MI : UNDER 37 CFR 1.47(a)
For: TRANSFERRIN RECEPTOR GENES OF :
MORAXELLA :

This is a decision on applicant's petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 30 April 2001. Applicant also requested a five month extension of time, which is granted.

BACKGROUND

On 30 April 2001, applicants, in response to 31 October 2000 Notification of Missing Requirements, filed a petition in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Run-Pan Du on the grounds that the non-signing inventor refused to execute the declaration. The petition included the requisite petition fee, a verified statement of counsel Michael I. Stewart, regarding Mr. Du's refusal to sign and a declaration signed by the 37 CFR 1.47(a) applicants, Lisa E. Myers, Anthony B. Schryvers, Robin E. Harkness, Sheena M. Loosmore, Yan-Ping Yang and Michel H. Klein on behalf of Run-Pan Du.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application

or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Items (1) and (3) have been submitted and satisfy the requirements of 37 CFR 1.47(a).

With respect to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in part:

The affidavit or declaration of facts must be signed; where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the

application oath or declaration, that reason should be stated in the affidavit or declaration.

[Emphasis added]

Here, Petitioner submitted an affidavit as to Facts under 37 CFR § 1.47(a)(2) executed by Mr. Stewart, who does not have first hand knowledge of the inventor's refusal. Paragraph five (5) of his declaration states that "I am advised by Dr. Gavin Zealey of the Patents Department of Aventis Pasteur Limited the Declaration and Power of Attorney executed by Run-Pan Du was forwarded to him by Federal Express, to his last known address...with a request for execution and return". This is insufficient evidence to conclude that applicant/inventor Run-Pan Du has refused to sign the application. What is required is that Mr. Du be presented with a copy of all of the national stage application papers (oath and declaration, specification, including claims and drawings) for the above identified application. The affidavit as to Facts under 37 CFR 1.47(a)(2) should be signed by the person having first hand knowledge of the inventor's refusal.

Petitioner has not demonstrated that: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 09/673,133 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature, sent to his last known address and (2) Mr. Du's refusal to sign, either in writing or by telephone, these documents.

As for item (4), applicant submitted two complete declarations in an attempt to satisfy the requirements of 37 CFR 1.47(a). One declaration is signed by applicant/inventors Lisa E. Meyers, Robin E. Harkness, Sheena M. Loosmore, Yan-Ping Yang and Michael Klein on behalf of non-signing inventor Run-Pan Du, whose signature line is left blank. The declaration has a line drawn through the box indicating the mailing address, residence, citizenship, signature line for applicant/inventor Anthony R. Schryvers, which would indicate that he is incorrectly listed on the declaration. The second declaration is signed by Anthony R. Schryvers with lines drawn through the box indicating the mailing address, residence, citizenship and signature line for all the other applicant/inventors including the non-signing inventor Run-Pan Du. The declaration are unacceptable and new declarations must be submitted before status under 37 CFR 1.47(a) can be attained.

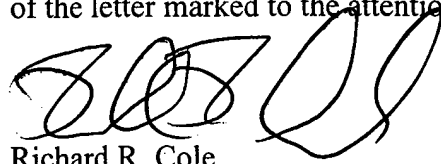
In sum, the evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application for the reasons set forth above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

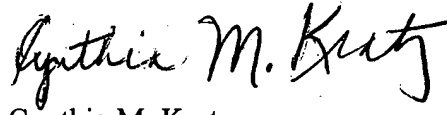
The petition under 37 CFR §1.47(a) is **DISMISSED** without prejudice.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No additional petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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